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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,251	09/24/2001	Hisashi Kawanabe	029430-486	6738

7590

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/25/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,251

Applicant(s)

KAWANABE ET AL.

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Art Unit: 1711

1. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for urethane resins derived from non-aromatically bound isocyanate group containing polyisocyanates, does not reasonably provide enablement for urethane resins derived from aromatic polyisocyanates having aromatically bound isocyanate groups. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicants have disclosed that the aforementioned polyisocyanate condition is to be met and the position is taken that the claims should be so limited.

2. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The structures of applicants' amended polyisocyanates, diisocyanatobenzene and bis(1-isocyanato-1,1-methylethyl)benzene, are unclear. Furthermore, it is unclear that the diisocyanates meet applicants' condition that the isocyanate groups not be aromatically bound.

3. Claims 5-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 12, the structures of applicants' amended polyisocyanates, diisocyanatobenzene and bis(1-isocyanato-1,1-methylethyl)benzene, are unclear. Furthermore, it

Art Unit: 1711

is unclear that the diisocyanates meet applicants' condition that the isocyanate groups not be aromatically bound.

With respect to claims 5, 6, 9, 18, 21, and 22, it is unclear what constitutes "derivatives of the polyisocyanates ..." (claims 5, 18, 21, and 22), "a modified isocyanurate or prepolymer ..." (claim 6), and "its modification" (claim 9).

Within claim 7, it is unclear what claim element's viscosity is being referred to; does the viscosity refer to component (A) or (B) or to the resulting mixture.

Within claim 8, applicants' claimed time requirement is essentially meaningless, absent some recitation of reaction conditions or a standard that will govern the means by which the reaction or viscosity build progresses. For example, the claim, as currently drafted, may merely reflect the fact that the temperature of a normally rapidly reacting system has been decreased to the point that the reaction is retarded.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2000-49387.

Art Unit: 1711

The reference discloses the use of a urethane as a sealant in the production of a light emitting diode. Given the components of the composition and its utility in the manufacture of optical elements, the position is taken that the claimed properties are inherent characteristics of the disclosed composition. See abstract.

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. Claims 1, 2, 4, 5, 8-11, 13-16, 21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 422836.

The reference discloses a transparent urethane composition that comprises the reaction product of reactants that meet those claimed by applicants. See abstract. Given the components of the composition and its utility in the manufacture of optical elements, the position is taken that the claimed properties are inherent characteristics of the disclosed composition.

8. Claims 1, 2, 4-8, 12-16, 21, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 659790.

The reference discloses a transparent urethane composition that comprises the reaction product of reactants that meet those claimed by applicants. See abstract. Given the components of the composition and its utility in the manufacture of optical elements, the position is taken that the claimed properties are inherent characteristics of the disclosed composition.

Art Unit: 1711

9. Claims 1, 2, 4, 5, 7, 8, 12-16, 21, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Yean et al. ('847).

Patentees disclose a transparent urethane composition that comprises the reaction product of reactants that meet those claimed by applicants. See abstract, columns 2 and 3, and examples. Given the components of the composition and its utility in the manufacture of optical elements, the position is taken that the claimed properties are inherent characteristics of the disclosed composition.

10. Claims 1-8, 13-19, 21-23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubota et al. ('156).

Patentees disclose a solar cell comprising a transparent urethane composition that comprises the reaction product of reactants that meet those claimed by applicants. See example 6. Given the components of the composition and its utility in the manufacture of optical elements, the position is taken that the claimed properties are inherent characteristics of the disclosed composition.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent

June 22, 2003


RABON SERGENT
PRIMARY EXAMINER